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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FADOK, MARK A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/412,404

Applicant(s)

KAPLAN, JOSHUA D.

Examiner

Mark A Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-38 and 52-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 21-38, and 52-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The examiner is in receipt of Applicant's response to Office action dated April 19, 2002, which was received by the Office 8/12/2002. The response has been carefully reviewed and based on this review the following comments are provided. With respect to the new matter rejection 35 USC § 132, the examiner concurs with applicants remarks and thus removes the rejection. In response to the 112 objection regarding the discrete ratings selection language, applicant's "about 5" change for the language "between 3 and 8" discrete rating selections" has created a new rejection, which is stated below. The claim objection under 37 CFR § 1.75(c) has been sufficiently corrected, therefore the objection has been removed. The two claim rejections under 112 first paragraph (enablement for written works, and preamble language) has been sufficiently answered, therefore the rejections has been removed.

The Examiner acknowledges that claims 39-51 and 61-66 have been canceled and claims 21,25-38 and 52-60 have been amended, leaving claims 21-38, and 52-60 as pending. However, the claims remain rejected and the new rejection necessitated by amendment is provided below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 52,54,55,57,and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The amendment changes the claimed feature language from "between 3 and 8" to "about 5" discrete rating selections. It is unclear to the Examiner how many discrete rating selections the applicant is claiming. Furthermore, the examiner notes that the applicant has only identified, in response to the previous rejection, the use of 2 and 5 discrete rating selections within the specification.

Claims 26-38,55-60 provide for the use of several processes, but, since the claims do not set forth any steps involved in the processes, it is unclear what processes applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 26-38, and 55-60 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims 26-38, and 55-60 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of

elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: "Purchasing process" and "identification process". Also, amending the claims to read "process for" from "means for" does not overcome the indefiniteness as stated in Jenson1 (see PTO form 892)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21,23,25-30,32-34,36-38,53,56,and 59 are rejected under 35

U.S.C. 103(a) as being unpatentable over Music Boulevard (the combination of Jensen2, Interactive Daily, USATODAY.com, Kramer, and Multimedia Week, See provided form PTO-892), and further in view of Brickman.

In response to claim 21, Music Boulevard discloses a method for enabling a remote user to preview a portion of a prerecorded video product from a network web site containing pre -selected portions of different prerecorded video products, using a computer, a computer display and a telecommunications link between the remote user's computer and the network web site, the method comprising the steps of:

a) using the remote user's computer to establish a telecommunications link to the network web site wherein the network web site comprises (i) a central host server coupled to a communications network for retrieving an[d] transmitting the pre-selected portion of the pre-recorded video product upon request by a remote user and (ii) a central storage device for storing pre-selected portions of a plurality of different pre-recorded video products (Jensen2, page 25, lines 5-16); Music Boulevard teaches a the transmission of digital content from a multimedia music store on the World Wide Web that allows listeners to hear 30-second music clips and also provides video information (Multimedia Week, entire article), but does not specifically mention the transmission of video. Brickman teaches a method for the delivery of digital content including video and the tracking of subscriber's usage (see entire article). It would be obvious to a person of ordinary skill in the art to include in Music Boulevard, the transmission of video as taught by Brickman, because video is another form of digital content and sales of video over the internet was old and well known in the art (Kramer, page 2, para. 7). Furthermore, including this additional digital content onto the website of Music Boulevard would considerably increase sales and allow users to view the video product they already promote on the website (Multimedia Week).

b) prior to previewing a pre-selected portion of a pre-recorded video product transmitting user identification data from the remote users computer to the central host server thereby allowing the central host server to identify and track the user's progress through the network web site (Jensen2, page 21, line 15 to page 24, line28);

c) choosing at least one pre-selected portion of the pre-recorded video products from the central host server (Jensen, page 25, lines 5-17);

d) receiving the chosen pre-selected portion of the pre-recorded products (Jensen2, page 25, lines 20-25);

e) interactively previewing the received chosen pre-selected portion of the pre-recorded video product (Jensen2, page 26, lines 1-29); and storing data corresponding to the remote user's activities on the network web site along with the user identification in a manner that allows pre-selected portions of pre-recorded video products previewed by a remote user to be associated with the remote user who previewed them (see discussion above and Jensen2, page 24, lines 21-25).

22.

In response to claim 23, Music Boulevard teaches wherein the central memory device comprises a plurality of compact disc - read only memory (CD-ROMs) (Kramer and Multimedia Week).

In response to claim 25, Music Boulevard discloses a method for enabling a remote user to preview a portion of a prerecorded video product from a network web site containing pre-selected portions of different prerecorded video products, using a computer, a computer display and a telecommunications link between the remote user's computer and the network web site, the method comprising the steps of:

a) using the remote user's computer to establish a telecommunications link to the network web site wherein the network web site comprises (i) a central host server coupled to a communications network for retrieving and transmitting the pre-selected

portion of the pre-recorded video product upon request by a remote user and (ii) a central storage device for storing pre-selected portions of a plurality of different pre-recorded video products;

b) prior to reviewing a pre-selected portion of a pre-recorded video product transmitting user identification data from the remote user's computer to the central host server thereby allowing the central host server to identify and track the user's progress through the network web site;

c) choosing at least one pre-selected portion of the pre-recorded video products wherein the portion of the pre-recorded product is identified by a product code.

d) receiving the chosen pre-selected portion of the pre-recorded video products;
e) interactively previewing the received chosen pre-selected portion of the pre-recorded video product: and storing data corresponding to remote user's activities on the network web site along with the user identification in a manner that allows pre-selected portions of pre-recorded video products previewed by a remote user to be associated with the remote user who previewed them (see response to claim 21). Concerning the product code, product codes such as SKU's are old and well known in the art and are often used to identify products in inventory. Therefore, it would have been inherent in Music Boulevard that product codes would be utilized, because the product would need to be identified by some kind of code in order to keep track of the thousands of different products available for pre-view on the website. (see also, Jensen2, page 27, lines 3-11).

In response to claim 26, Music Boulevard discloses a computer system comprising:

a) a networked central host server that retrieves and transmits a pre-selected portion of a pre-recorded video product upon request by a remote user over a telecommunications link, the central host server hosting a web site that enables preview of pre-selected portions of prerecorded video products on a computer associated with the remote user (see response to claim 21 and Multimedia week);

b) a central storage device that stores pre-selected portions of a plurality of different pre-recorded video products, the central storage device coupled to the central host server; and

c) machine executable programs of instructions that provide: an identification (ID) process that recognizes user identification data, transmitted from the remote user's computer to the central host server, which specifically identifies the remote user to the central host server prior to review of the pre-selected portion of the pre-recorded video product by the remote user; a tracking process that tracks the remote user's progress through the network web site; and a control process that provides the remote user with interactive control over the preview of the pre-selected portion of the pre-recorded video products; wherein data corresponding to the remote user's activities on the network web site is stored along with the user identification data in a manner that allows pre-selected portions of pre-recorded video products previewed by remote user to be associated with the remote user who previewed them (see response to claims 21 and 25).

In response to claim 27, Music Boulevard teaches wherein the portions of the plurality of different pre-selected pre-recorded video products are identified and called from the central storage device using unique product codes. Product codes such as SKU's are old and well known in the art and are often used to identify products in inventory. Therefore, it would have been inherent in Music Boulevard that product codes would be utilized, because the product would need to be identified by some kind of code in order to keep track of the thousands of different products (see response to claim 26).

In response to claim 28, Music Boulevard teaches a machine executable program of instructions that provides a purchasing process that allows the user to place an order for purchasing at least one video product (USATODAY.com).

In response to claim 29, Music Boulevard teaches a machine executable program of instructions that provides a listing process that provides the user with dynamic lists of the pre-selected portions of the plurality of different pre-recorded video products that have been previewed the most (Jensen2, page 8, lines 1-16).

In response to claim 30, Music Boulevard teaches a machine executable program of instructions that provides a recording process that provides the user with a record of previous previews by the user (see response to claim 29)

In response to claim 32, Music Boulevard teaches a machine executable program of instructions that provides a first market research process that correlates the user's rating with the user identification data, for compiling market research data (See response to claim 31 and Jensen page 24, lines 16-25).

In response to claim 33, Music Boulevard teaches machine executable program of instructions that provides a second market research process that correlates the user identification data with all previews performed by the remote user, for compiling market research data (Jensen2, page 21, line 15 to page 24, line 25).

In response to claim 34, Music Boulevard discloses a computer system comprising:

a) a networked central host server that retrieves and transmits a pre-selected portion of a pre-recorded video product upon request by a remote user over a telecommunications link, the central host server hosting a web site that enables preview of pre-selected portions of pre-recorded video products on a computer associated with the remote user;

b) a central storage device that stores pre-selected portions of a plurality of different pre-recorded video products, the central storage device coupled to the central host server;

c) machine executable programs of instructions that provide: an identification (ID) process that recognizes user identification data transmitted from the remote user's computer to the central host server, which specifically identifies the remote user to the central host server prior to preview of the pre-selected portion of the pre-recorded video product by the remote user; a tracking process that tracks the remote user's progress through the network web site; a control process that provides the remote user with interactive control over preview of the pre-selected portion of the pre-recorded video product; and a demographic process, associated with the central host server, that

collects demographic information regarding the user, wherein data corresponding to the remote user's activities on the network web site is stored along with the user identification data in a manner that allows pre-selected portions of pre-recorded video products previewed by a remote user to be associated with the remote user who previewed them (see response to claim 1 and Jensen2, page 21, line 15 to page 24, line 25).

In response to claim 36, Music Boulevard teaches a machine executable program of instructions that provides a first market research process that correlates the user rating with the user identification data, for compiling market research data (see response to claim 32).

In response to claim 37, Music Boulevard teaches machine executable program of instructions that provides a second market research process that correlates the user ID with all previews perform by the user, for compiling market research data (see response to claim 33).

In response to claim 38, Music Boulevard teaches wherein the demographic information is selected from the group of information types consisting of age, sex, income, ethnicity, education level, marital status, hobbies, and occupation (Jensen2, page 24, lines 17-20).

In response to claim 53, Music Boulevard teaches gathering, from the network web site, customized market research information according to one or more desired parameters selected from the group consisting of unit sales, time periods, geographic

markets, specific video categories, configuration breakdowns, and demographic user profiles (Jensen2, page 8, lines 1-16).

In response to claim 56, Music Boulevard teaches machine executable program of instructions that provides a customizable market research process that gathers, from the network web site, customized market research information according to one or more desired parameters selected from the group consisting of unit sales, time periods, geographic markets, specific video categories configuration breakdowns, and demographic user profiles (see response to claim 53).

In response to claim 59, Music Boulevard teaches a machine executable program of instructions that provides a customizable market research process that gathers, from the network web site, customized market research information according to one or more desired parameters selected from the group consisting of unit sales, time periods, geographic markets, specific video categories, configuration breakdown and demographic user profiles (see response to claim 53).

Claims 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Music Boulevard in view of Brickman, and further in view of Koz et al (6,188,428).

In regards to claim 42, Music Boulevard teaches memory storage devices (col. 19, lines 43-49), but does not specifically state RAID. KOZ teaches a random access data storage system subsystem 78 that includes a "Redundant Array of inexpensive Disks" (RAID (col. 8, lines 54-58). It would be obvious to a person of ordinary skill in the art to included in Music Boulevard/Brickman a Raid array drive as taught by Koz, because if

one memory device were to be down the other could supplant it and provide uninterrupted data.

Claims 22,31,35,52,54,55,57,58,60 rejected under 35 U.S.C. 103(a) as being unpatentable over Music Boulevard in view of Brickman, and further in view of Miller et al (5,842,199).

In regards to claims 52,54,55,57,58,60, Music Boulevard teaches the collection of customer profile information which is used to determine preferences (Jensen2, page 24, lines 16-21)), but does not specifically mention rating a product using between 3 and 8 discrete rating selections, displayed graphically on a computer display. Miller teaches that explicit rating methods in collaborative filtering systems are single keystrokes entered by users. The keystrokes usually represent values along a single ordered dimension, discretized for ease-of-entry. Miller does not limit the number of discrete rating selection and therefore could include about 5. It would be obvious to a person of ordinary skill in the art to include in Music Boulevard/Brickman the rating method as taught by Miller, because the ratings can provide value to a web site by providing visitors information that may reduce the time needed to make a purchase.

Response to Arguments

Applicant's arguments with respect on the merits of claims 21,25-38 and 52-60 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Several cited references provide strong clues concerning the existence of materials, not yet of record, relevant to applicant's invention. Applicant is reminded of his duty to disclose under 37 CFR 1.56.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 8/9/2002 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Friday 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Mark Fadok

Patent Examiner



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